

P-3818

RemarksIntroduction

Claims 1, 5-9, 19 and 20 are pending. Claim 1 has been amended, and claims 19 and 20 added.

This application was appealed, the Board upheld the Examiner's rejections in a decision mailed September 19, 2005, and Applicant has filed a Request for Continuing Examination along with this Preliminary Amendment.

Claim Rejections

The Examiner previously rejected claims 1, 5, 7, and 8 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,458,854 to Burns, and rejected claims 6 and 9 under 35 U.S.C. § 103(a) as being unpatentable over ("Burns"). The rejections are respectfully traversed.

Claim 1, as amended, recites an assembly with the following features:

- an elongate tubular housing having opposed first and second ends
- a solid partition positioned within said housing between the first and second ends, the housing defining a volume
- the second end having a bottom end below said partition, the bottom end having an annular skirt and a semi-spherical bottom

Previously, the claim recited that the bottom end comprised a rounded bottom. The Board broadly interpreted this claim element as including the tubular, but flat, bottom of Burns.

As to amended claim 1, Burns does not disclose: a bottom end below a solid partition, with the bottom end comprising an annular skirt and a semi-spherical bottom. In Burns, only an annular skirt 37 exists below the partition – there is no semi-spherical bottom.

For these reasons, Burns does not anticipate claim 1.

Nor would Burns render claim 1 obvious.

P-3818

If a user of the Burns collection container desired compatibility with diagnostic equipment, Burns provides its own solution – one or more extensions (90) placed into the annular skirt (37). (See Figs. 7 and 8, and Col. 5, lines 13-24.) Thus, the only motivation the Examiner has presented for changing the Burns design, i.e., compatibility, is already addressed within Burns itself. One skilled in the art, reading Burns, would have no apparent need to modify the Burns container for diagnostic compatibility.

In addition, Burns discloses that its annular skirt has 2 specific functions – allowing the assembly to be placed upright on a flat surface (Col. 3, lines 50-52), and being compatible with the container cap, such that the cap can be retained at the bottom of the Burns assembly during sample collection (Col. 5, lines 7-12). Modifying the Burns container in the manner necessary to reach Applicant's claimed invention goes against these explicit functions of the Burns container. One would not do so, particularly where Burns provides its own solution to the issue of compatibility with equipment.

Moreover, such a modification of the Burns container would in fact destroy these 2 functionalities, since a rounded bottom would not allow one to place the container on a flat surface, nor would the rounded bottom retain the cap during use. It is well-accepted that an obviousness rejection based on modifying or combining references in a manner that destroys the references' intended function cannot stand. See, e.g., In re Gordon, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984).

In view of the amendments and remarks above, Applicant respectfully requests reconsideration of the application, and allowance of all claims.

If there are any additional fees related to this Amendment, such fees should be charged to Deposit Account No. 02-1666.

Respectfully submitted,

By: M. Lindsey
Mark Lindsey, Agent
Reg. No. 52,515
201-847-6262

Date: November 11, 2005
Becton, Dickinson & Company
1 Becton Drive, MC 089
Franklin Lakes, New Jersey 07417-1880